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TO: Mail Stop RCE, Examiner Michael A. Brown

FIRM/COMPANY: Commissioner for Patents

FACSIMILE NUMBER: (703) 872-9306

**CONFIRMATION
TELEPHONE:**

FROM: Ruth Der, Paralegal

DIRECT DIAL: 415.371.2231

DATE: September 14, 2004

USER NUMBER:

FILE NUMBER: U.S. Serial No. 09/911,551, Atty. Docket No. R0371-00402

TOTAL # OF PAGES: 8
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MESSAGE: Attached are *Request For Continued Examination Under 37 CFR §1.114* and *Information Disclosure Statement* and accompanying papers.

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of
Callister et al.

Examiner: M. A. Brown

Group Art Unit: 3764

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For: **OCCLUDING DEVICE AND
METHOD OF USE**

SEP 14 2004

Serial No.: 09/911,551

Filed: July 23, 2001

**REQUEST FOR CONTINUED
EXAMINATION UNDER 37 CFR §1.114**

Atty. Docket No.: R0371-00402

CERTIFICATE OF MAILING/FACSIMILE PURSUANT TO 37 C.F.R. §1.8

I hereby certify that this these papers are being sent by facsimile to (703) 872-9306 addressed to Examiner Michael A. Brown,
at Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on 9/14/2004, in San Francisco, CA.
By: [Signature]

Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is a request for continued examination (RCE) under 37 C.F.R. § 1.114 of the above-identified application.

1. **Submission required under 37 C.F.R. § 1.114**a. ☐ Previously submitted

i. ☐ Consider the amendment(s)/reply under 37 C.F.R. § 1.116 previously filed on _____ (any unentered amendment(s) referred to above will be entered).

ii. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on _____.

iii. ☐ Other: _____.

b. ☒ Enclosedi. ☐ Amendment/Replyii. ☐ Affidavit(s)/Declaration(s)iii. ☒ Information Disclosure Statement (IDS)iv. ☐ Other:

2. **Filing Fees**

Description	Fee Code	Claims	Extra	Rate	Fee
RCE Fee	2801				\$385.
Independent Claims	2201	7 - 3 =	4 x	\$43=	\$172.
Total Claims	2202	72 - 20 =	52 x	\$9 =	\$468.

Total Fees Due.....\$1025.

3. **Payment of Fees**

☒ The Commissioner is hereby authorized to charge any fees and to credit any overpayment of fees which may be required under 37 CFR §1.16 and §1.17, to Deposit Account No. 04-1679, referencing Atty. Docket No. R0371-00402. A duplicate of this sheet is enclosed for this purpose.

4. **Address all future communications to:**

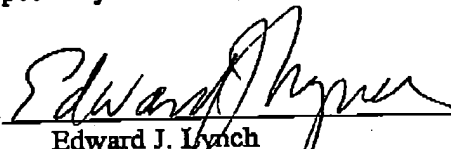
Edward J. Lynch
DUANE MORRIS LLP
One Market
Spear Tower, Suite 2000
San Francisco, CA 94105

5. **Other documents enclosed herewith:**

☐ Other (Specify: _____).

Respectfully submitted,

By:


Edward J. Lynch
Registration No. 24,422
Attorney for Applicants

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One Market
Spear Tower, Ste. 2000
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_____ (any unentered amendment(s) referred to above will be
entered).

ii. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on
_____.

iii. ☐ Other: _____.

b. ☒ Enclosed

i. ☐ Amendment/Reply

ii. ☐ Affidavit(s)/Declaration(s)

iii. ☒ Information Disclosure Statement (IDS)

iv. ☐ Other: _____

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Respectfully submitted,

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**INFORMATION
DISCLOSURE STATEMENT****CERTIFICATE OF MAILING/FACSIMILE PURSUANT TO 37 C.F.R. §1.8**

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By: 

Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The concurrently filed Request for Continued Examination has been filed to enable the Patent Office to consider documents related to litigation involving U.S. Patent Nos. 6,096,052 and 6,423,116, both which relate to the present application. The first lawsuit involved U.S. Patent No. 6,096,052 and was identified as Civil Action No. C 02-1968 MHP in the United States District Court for the Northern District of California. The second lawsuit involved U.S. Patent Nos. 6,096,052 and 6,423,116 and was identified as Civil Action No. C 02-3884 MHP in the United States District Court for the Northern District of California. Both patents in suit are assigned to Ovion, Inc. the assignee of the present application.

In the first lawsuit (Civil Action No. C 02-1968 MHP), Conceptus, Inc. filed a Complaint For Declaratory Judgment Of Patent Non-Infringement, Invalidity And Unenforceability (Docket No. 1). Conceptus, Inc. later filed a First Amended Complaint For (1) Declaratory Judgment Of Patent Non-Infringement, Invalidity And Unenforceability; (2) False Advertising Under 15 U.S.C. § 1125(A); (3) Trade Libel; (4) Unfair Competition Under Common Law And Cal. B&P § 17200

Et. Seq.; (5) Unjust Enrichment; and (6) Constructive Trust. The Defendants (Ovion, Inc.) contended that the First Amended Complaint should be dismissed for lack of subject matter jurisdiction. Accordingly, although the Defendants dispute many of the allegations in the First Amended Complaint, the Defendants did not file an Answer.

In the second lawsuit (Civil Action No. C 02-3884 MHP), Ovion, Inc. filed a Complaint For Patent Infringement against Conceptus, Inc. (Docket No. 1). In turn, Conceptus, Inc. filed Conceptus' Answer To Ovion's Complaint, Affirmative Defenses And Counterclaims (Docket No. 11). Subsequently, Conceptus, Inc. filed Conceptus's Amended Answer To Ovion's Complaint, Affirmative Defenses And Counterclaims. Ovion, Inc. then filed Ovion's Reply To Amended Counterclaims Of Conceptus. At the time the litigation settled, Ovion, Inc. had submitted to the judge, with a request for leave to file, a First Amended Complaint For Willful Patent Infringement, Fraud And Misrepresentation, Misappropriation, Unjust Enrichment, Unfair Business Practices, Trade Libel, Slander Of Title, Monopolization, Attempt To Monopolize And Sham Litigation. Similarly, at the time the litigation settled, Conceptus, Inc. had submitted to the judge, with a request for leave to file, Conceptus' Second Amended Answer, Affirmative Defenses And Counterclaims For: (1) Declaratory Judgment Of Non-Infringement; (2) Declaratory Judgment Of Unenforceability; (3) Declaratory Judgment Of Invalidity; (4) Correction Of Inventorship Of '052 Patent Under 35 U.S.C. § 256; (5) Correction Of Inventorship Of '116 Patent Under 35 U.S.C. § 256; (6) Fraud And Deceit; (7) Trade Libel; (8) Slander Per Se; (9) Libel; (10) Unfair Competition; And, (11) Slander Of Title.

Both lawsuits were dismissed with prejudice pursuant to a settlement agreement between Ovion, Inc. and Conceptus


The applicants are presently collecting documents for submission pursuant to the provisions of MPEP 2001.06(c). Applicants will submit collected documents in due course in a good faith attempt to provide the U.S. Patent and Trademark Office with sufficient information to

evaluate the issues and whether to ask for additional information or material. If the Office desires additional information or material, the applicants will provide it to the extent possible.

As will be evident from the documents submitted, the parties disputed, among other things, patent infringement, validity, enforceability, and inventorship. The parties also disputed construction of patent claims. However, Both lawsuits were dismissed with prejudice by stipulation pursuant to the settlement agreement, so the court did not make a final determination as to the merits of the allegations and contentions of any of the parties.

The Commissioner is authorized to charge any fees and to credit any overpayment of fees which may be required under 37 C.F.R. §1.16 or §1.17, to Deposit Account No 04-1679, referencing Atty. Docket No. R0371-00402.

Respectfully submitted,

By: 
Edward J. Lynch
Registration No. 24,422
Attorney for Applicants

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